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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,879	12/16/1999	JOHN L. BEEZER	3797.84611	9430

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EXAMINER

TRAN, MYLINH T

ART UNIT	PAPER NUMBER
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2174

DATE MAILED: 12/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/465,879

Applicant(s)

JOHN L. BEEZER

Examiner

Mylinh T Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Amendment filed 10/23/02.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-9 and 11-20-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-9 and 11-20-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's Amendment filed 10/23/02 has been entered and carefully considered. Claims 1 and 9 have been amended. Claim 28 has been added. Claim 2 and 10 have been cancelled. However, limitations of amended claims have not been found to be patentable over prior art of record and newly discovered prior art, therefore claims 1, 3-9, 11-23 and 25-28 are rejected under the new ground of rejection as set forth below.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claim 1, 3-9, 11-17, 19-20, 22-23, 25 and 27-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Sachs et al. [US. 5,956,034].

As to claims 1 and 9, Sachs et al. discloses displaying at least a portion of the electronic document to the user as an immersive reading page, the immersive reading page mimicing a printed paper (figure 3A, (100), column 2, lines 50-60 and column 5, lines 41-52); associating with an element of the immersive

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reading page enhanced page functionality (column 5, lines 52-65, column 6, lines 1-13 and column 6, lines 41-52). Sachs et al. cites "Navigation of the reading materials is effected by different functions as represented by a plurality of function display" read as the enhanced page functionality. Each icon in figure 3B, (120-138) represents one enhanced functionality; providing the user access to the enhanced functionality in response to the user selecting the element of the immersive reading page (column 5, lines 57-60, Sachs cites "Similarly, an icon representing the function of turning to the previous page enables the user to go back through the text"); wherein the immersive reading page is configured to selectively provide or not provide a visual indication (Each icon (figure 3B, 122-138), column 6, lines 1-15 is read as visual indication) to the user to the enhanced functionality (column 6, lines 43-50). Applicant's attention is directed to the lines "when the "dictionary" icon is selected. The portable display unit includes the ability to automatically look up and display the dictionary definition of a work in the text" read as provide a visual indication to the user to the enhanced functionality; the visual indication appears directly on the immersive reading page (figure 4A, (146-154), column 6, lines 43-50). All visual indications (icons) are right on the immersive reading page 60c of figure 4A.

As to claims 3 and 11, Sachs et al. also discloses the enhanced functionality is transparently associated with the element of the immersive reading page (figure 4A, (142), column 4, lines 50-55).

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As to claims 4 and 12, Sachs et al. teaches the step of invoking a training mode for teaching the association to a user (figure 2B, (86a), column 4, lines 35-55).

As to claims 5 and 13, Sachs et al. also teaches the element that is a page number and the step of associating comprises associating intrabook navigational functionality with the page number (column 5, lines 51-55 and column 8, lines 60-68).

As to claims 6 and 14, Sachs et al. shows the element is a title line and the step of associating comprises associating interbook navigational functionality with the title line (column 7, lines 37-44).

As to claims 7 and 15, Sach et al. also shows the element is content and the step of associating comprises associating content interaction functionality with the content (column 7, lines 44-55).

As to claims 8 and 16, Sachs et al. demonstrates the step of associating comprises the step of associating a first category of enhanced functionality with a first category of element on the immersive reading page (column 5, lines 44-55).

As to claims 17 and 23, Sachs et al. also demonstrate the enhanced functionality includes highlighting (column 7, lines 1-18).

As to claims 19 and 28, Sachs et al. suggests the enhanced functionality includes drawing (column 2, lines 50-55).

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As to claims 20 and 25, Sachs et al. also suggest the enhanced functionality includes adding a bookmark indicator in relation to the immersive reading page (column 5, line 65 through column 6, line 5).

As to claims 22 and 27, Sachs et al. discloses the electronic document is a book in electronic form and the immersive reading page mimics a printed paper page of a book (column 1, lines 47-58 and column 2, lines 62-68).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18, 21, 24 and 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs et al. [US. 5,956,034] in view of Sachs et al. [US. 6,493,734].

As to claims 18, 21, 24 and 26, the difference between Sachs [US. 5,956,034] and the claim is the enhanced functionality includes annotating and a note to the immersive reading page. Sachs et al. [US. 6,493,734] shows the feature at column 3, lines 50-58. It would have been obvious to one of ordinary skill in the art, having the teachings of Sachs [US. 5,956,034] and Sachs [US. 6,493,734] before them at the time the invention was made to modify the enhanced functionality taught by Sachs et al. [US. 5,956,034] to include specific features

functionality of Sachs [US. 6,493,734], with the motivation being to be able to provide additional advantageous features to the users as taught by Sachs [US. 6,493,734].

***Response to Arguments***

Applicant's argument with respect to claims 1, 3-9 and 11-28 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires fax a response, (703) 746-7238, may be used for formal After Final communications, (703) 746-7239 for Official communications, or (703) 746-4395 for Non-Official or draft communications. NOTE, A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for information facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Fourth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mylinh Tran whose telephone number is (703) 308-1304. The examiner can normally be reached on Monday-Thursday from 8.00AM to 6.30 PM

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If attempt to reach the examiner by telephone are unsuccessful, the examiner 's supervisor, Kristine Kincaid, can be reached on (703) 308-0640,

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Mylinh Tran

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